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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,448	07/18/2003	Tsutomu Ohishi	240473US2	1119
22850 7590 06/26/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER KAU, STEVEN Y	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 06/26/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	Application No. 10/621,448	Applicant(s) OHISHI ET AL.	
	Examiner Steven Kau	Art Unit 2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10/20/2003, 12/11/2003, 1/2/2004, 6/14/2004, 10/25/200~~5~~<sup>4</sup>, 1/13/2006, 11/22/2005, 5/31/2006, 10/20/2006.

### **DETAILED ACTION**

1. The information disclosure statement (IDS) submitted on 10/20/2003, 12/11/2003, 01/02/2004, 06/14/2004, 10/25/2004, 11/22/2005, 01/13/2006, 05/31/2006 and 10/20/2006 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 12-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 12-21 are drawn to "a computer program", which can be characterized as either "functional descriptive material" or "nonfunctional descriptive material". Since the computer program comprising steps of referring to launch selection information of a location, storing application and launching the application in the selected location. Therefore, it is being considered as

Art Unit: 2625

“nonfunctional descriptive material” because “a computer program” per se in the claims can merely be an abstract idea.

Also, considering the claim as “functional descriptive material” imparts with functionality, but not being employed as a computer component (or other physical structures), is considered not statutory. “In contrast, a claimed computer-readable medium encoded with a computer program... is thus statutory.” (See “*Interim Guideline for Examination of Patent Application for Patent Subject Matter Eligibility*”, ANNEX IV, Page 53, First Paragraph;).

Therefore, both types of “descriptive material” are nonstatutory when claimed as descriptive material per se (See “*Interim Guideline for Examination of Patent Application for Patent Subject Matter Eligibility*”, ANNEX IV, Page 50, Second Paragraph;). As well as the claimed program is not necessarily a computer program, and is not encoded or embodied on a computer readable medium, there is no structural and functional interrelationships, thus, the claim is considered non-statutory.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 19 and 11-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Morita (US 2002/0054326).

With regard to claim 1, Morita discloses a method of image formation and computer product, in that he anticipates an image forming apparatus {e.g. printer, copier, scanner, etc.} (Figures 1 & 2, Par. 0044 & 0051) that includes service modules {e.g. control service, engine control service (ECS), memory control service (MCS) and network control service (NCS), etc.} (Par. 0059) for performing system side processes on image formation {e.g. hardware resources control, display imaging, & processing request from an application, etc} (Par. 0059 & 0221), wherein applications can be added to the image forming apparatus separately from the service modules {e.g. applications can be added or deleted application by application} (Par. 0080), the image forming apparatus comprising: an application launch part {e.g. application management} (Par. 0063) for referring to launch selection information indicating at least a location that stores one or more applications {e.g. memory address} (Par. 0097), and launching the one or more applications from the at least a location according to the launch selection information {e.g. applications 311 (printer application) –316 (process inspection application) can execute operation, from an address of a memory} (Figures 4-7, Par. 0178 & Par. 195).

With regard to claim 2, Morita anticipates that the at least a location is at least one of a hard disk device, a recording medium removable from the image forming apparatus, a computer connected to the image forming apparatus via a network (Par. 0072).

With regard to claim 11, in accordance with claim 2, Morita anticipates that the image forming apparatus receives an application from the computer connected to the

image forming apparatus via a network by using an http protocol or an ftp protocol, and the application launch part launches the received application (0097).

With regard to claim 3, Morita anticipates that a part for displaying a setting screen for setting the launch selection information on a display part of the image forming apparatus, and storing information input from the setting screen as the launch selection information {e.g. a display section provides for user service} (Par. 0012).

With regard to claim 4, Morita anticipates that the application launch part launches the application by referring to information on the application {e.g. application management & control of the right of using the operation section} (Figures 4-7, Par. 0063 & 0064).

With regard to claim 5, in accordance with claim 4, Morita anticipates that the information referred to by the application launch part is address information of the application (Par 0097).

With regard to claim 6, Morita anticipates that the application launch part determines whether the application is installed at the location according to presence or absence of predetermined information on the application {e.g. a transfer destination PC such a URL (location)} (Par 0097), and the application launch part launches the application if the application is installed at the location {e.g. printer application executed by Engine Job Execution Control or by Fax Job Execution Control Module} (Figures 5 & 8, Par. 0086 & Par. 0105).

With regard to claim 7, Morita anticipates that the application launch part {e.g. application management} (Par. 0063) refers to setting information including information

indicating whether a predetermined application is to be launched {e.g. a previously defined function} (Par 0059), and the application launch part launches the predetermined application if the setting information includes information indicating the predetermined application is to be launched (Par. 0151).

With regard to claim 8, Morita anticipates that the application launch part refers to setting information including information indicating applications to be launched, and the application launch part launches the application indicated in the information {e.g. notifying its information to another application are conducted} (Par 0063).

With regard to claim 9, in accordance with claim 8, Morita anticipates that a part for displaying a setting screen for setting the setting information on a display part of the image forming apparatus, and storing information input from the setting screen as the setting information {e.g. displaying respective application screen} (Figure 17, Par. 0041 & Par. 0197).

With regard to claim 12, the structure elements of apparatus claim 1 perform all steps of computer program claim 12. Thus claim 12 is rejected under 102(b) for the same reason discussed in the rejection of claim 1.

With regard to claim 13, the structure elements of apparatus claim 1 perform all steps of computer program claim 12. Thus claim 12 is rejected under 102(b) for the same reason discussed in the rejection of claim 1.

With regard to claim 13, the structure elements of apparatus claim 2 perform all steps of computer program claim 13. Thus claim 13 is rejected under 102(b) for the same reason discussed in the rejection of claim 2.



With regard to claim 14, the structure elements of apparatus claim 3 perform all steps of computer program claim 14. Thus claim 14 is rejected under 102(b) for the same reason discussed in the rejection of claim 3.

With regard to claim 15, the structure elements of apparatus claim 4 perform all steps of computer program claim 15. Thus claim 15 is rejected under 102(b) for the same reason discussed in the rejection of claim 4.

With regard to claim 16, the structure elements of apparatus claim 5 perform all steps of computer program claim 16. Thus claim 16 is rejected under 102(b) for the same reason discussed in the rejection of claim 5.

With regard to claim 17, the structure elements of apparatus claim 6 perform all steps of computer program claim 17. Thus claim 17 is rejected under 102(b) for the same reason discussed in the rejection of claim 6.

With regard to claim 18, the structure elements of apparatus claim 7 perform all steps of computer program claim 18. Thus claim 18 is rejected under 102(b) for the same reason discussed in the rejection of claim 7.

With regard to claim 19, the structure elements of apparatus claim 8 perform all steps of computer program claim 19. Thus claim 19 is rejected under 102(b) for the same reason discussed in the rejection of claim 8.

With regard to claim 20, the structure elements of apparatus claim 9 perform all steps of computer program claim 20. Thus claim 20 is rejected under 102(b) for the same reason discussed in the rejection of claim 9.

With regard to claim 21, in accordance with 13, the structure elements of apparatus claim 11 perform all steps of computer program claim 21. Thus claim 21 is rejected under 102(b) for the same reason discussed in the rejection of claim 11.

With regard to claim 22, the structure elements of apparatus claim 1 perform all steps of computer readable medium claim 22. Thus claim 22 is rejected under 102(b) for the same reason discussed in the rejection of claim 1.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morita (US 2002/0054326) in view of Kimura (US 6,226,097).

With regard to claim 10, in accordance with claim 1, Morita differs from the claim, in that he does not teach that the image forming apparatus further comprising a virtual application service that operates as a client process for the services modules and operates as a server process for the applications, wherein the virtual application service includes the application launch part.

Kimura discloses a print interrupt method, in that he teaches the image forming apparatus further comprising a virtual application service {e.g. a virtual server/virtual print spooler/virtual print server provide virtual application services} (Figures 1, 7 & 8,

col 6, lines 4-13) that operates as a client process for the services modules (Figures 7 & 10, col 6, lines 1-13 & col 7, lines 13-38) and operates as a server process for the applications, wherein the virtual application service includes the application launch part {e.g. execute various types of programs such as application} (Figure 1, col 4, lines 15-36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Morita to include the image forming apparatus further comprising a virtual application service that operates as a client process for the services modules and operates as a server process for the applications, wherein the virtual application service includes the application launch part taught by Kimura because it is capable of continuing normal printing even if a user request interruption of data transmission and performs the next printing (col 1, lines 43-46).

### **Correspondence Information**

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 2625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is (571) 270-1120. The examiner can normally be reached on Monday to Friday, from 8:30 AM – 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Kau  
Patent Examiner  
Division: 2625  
June 12, 2007



KING Y. POON  
PRIMARY EXAMINER